UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,657	02/05/2001	Evan Stephen Crandall	105136.03	9298

7590   09/08/2004

S.H. Dworetsky
AT&T Corp.
P.O. Box 4110
Middletown, NJ 07748

EXAMINER
BAUGH, APRIL L

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/775,657	CRANDALL, EVAN STEPHEN
	Examiner	Art Unit	
	April L Baugh	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant amended claims 9 and 20 therefore claims 1-22 are now pending.

Response to Arguments

1.   Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-6, 9-17, and 20-22 rejected under 35 U.S.C. 102(e) as being unpatentable by US Patent No. 6,029,045 to Picco et al.

Regarding claim 1, Picco et al. teaches a method for transmitting a performance via a network, comprising: receiving performance information including one or more mixing commands via the network at a local performance reproduction device connected to the network; retrieving performance information stored in local storage (column 6, lines 19-29); composing a performance by mixing the performance information received from the network with the locally stored performance information based on the one or more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19), and

transmitting one or more portions of the performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claim 9, Picco et al. teaches a method for transmitting a performance via a network, comprising: receiving performance information including one or more mixing commands via the network at a local performance reproduction device connected to the network (column 6, lines 19-29); composing a first performance based on the one or more mixing commands; separating the first performance into performance components; modifying one or more of the performance components to create a second performance; retrieving performance information stored in local storage (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19): composing (a) the second performance by mixing the performance information received from the network with the locally stored performance information based on the one or more mixing commands; and transmitting one or more portions of the second performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claim 10, Picco et al. teaches a method for transmitting a performance via a network, comprising: receiving performance information including one or more mixing commands via the network at a local performance reproduction device connected to the network (column 6, lines 19-29); retrieving performance information stored in local storage: a method for transmitting a performance via a network, composing a performance by mixing the performance information received from the network with the locally stored performance information based on the one or more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19); adding a performance component to the performance

prior to transmitting the one or more portions of the received performance information; and

transmitting one or more portions of the performance, including the modified one or more

performance components (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column

15, lines 8-30).

Regarding claim 11, Picco et al. teaches a method for transmitting a performance via a

network, comprising: a method for transmitting a performance via a network, receiving

performance information including one or more mixing commands via the network at a local

performance reproduction device connected to the network (column 6, lines 19-29); retrieving

performance information stored in local storage composing a performance by mixing the

performance information received from the network with the locally stored performance

information based on the one or more mixing commands (column 8, lines 36-39 and column 9,

line 65 through column 10, line 4 and column 10, lines 13-19); buffering the received

performance information; receiving a request for transmission of the performance; and

transmitting the one or more portions of performance in response to the request for transmission

of the performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15,

lines 8-30).

Regarding claim 12, Picco et al. teaches a performance transmission device, comprising;

a receiver that receives performance information including one or more mixing commands via a

network (column 6, lines 19-29); a controller that composes a performance by retrieving

performance information stored in local storage and mixes the performance information received

from the network with the locally stored performance information based on the one or more

mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and

column 10, lines 13-19); and a transmitter that transmits one or more portions of the performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claim 20, Picco et al. teaches a performance transmission device, comprising: a receiver that receives performance information including one or more mixing commands via a network (column 6, lines 19-29); a controller that composes a performance by retrieving performance information stored in local storage and mixes the performance information received from the network with the locally stored performance information based on the one or more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19); a modification system which, based on user input, separates the first performance into performance components and modifies one or more of the performance components to create a second performance; and a transmitter that transmits one or more portions of the second performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claim 21, Picco et al. teaches a performance transmission device, comprising; a receiver that receives performance information including one or more mixing commands via a network (column 6, lines 19-29); a controller that composes a first performance by retrieving performance information stored in local storage and mixes the performance information received from the network with the locally stored performance information based on the one or more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19); a modification system which, based on user input, adds a performance component to the performance; and a transmitter that transmits one or more portions of the

performance, including the performance component added by the modification system (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claim 22, Picco et al. teaches a performance transmission device, comprising; a receiver that receives performance information including one or more mixing commands via a network (column 6, lines 19-29); a controller that composes a performance by retrieving performance information stored in local storage and mixes the performance information received from the network with the locally stored performance information based on the one or more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4 and column 10, lines 13-19); and a memory that buffers the received performance information; wherein the controller receives a request for transmission of the performance and causes the transmitter to transmit the one or more portions of performance via a transmitter in response to the request for transmission of the performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 15, lines 8-30).

Regarding claims 2 and 13, Picco et al. teaches the method of claims 1 and 12, wherein the transmitting one or more portions of the performance comprises transmitting one or more portions of the performance information received via the network (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 6, lines 19-29 and column 15, lines 8-30).

Referring to claims 3 and 14, Picco et al. teaches the method of claims 1 and 12, wherein the transmitting one or more portions of performance information comprises transmitting new information not included in the performance information received via the network (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 6, lines 19-29 and column 15, lines 8-30).

Regarding claims 4 and 15, Picco et al. teaches the method of claims 1 and 12, wherein

the composing the performance comprises: composing a first performance based on the one or

more mixing commands (column 8, lines 36-39 and column 9, line 65 through column 10, line 4

and column 10, lines 13-19); separating the first performance into performance components; and

modifying one or more of the performance components to create a second performance; and

wherein the transmitting the one or more portions of the performance comprises transmitting one

or more portions of the second performance (column 2, lines 37-42 and column 3, lines 1-9 and

25-27 and column 6, lines 19-29 and column 15, lines 8-30).

Referring to claims 5 and 16, Picco et al. teaches the method of claims 4 and 15, wherein

the modifying the one or more performance components comprises one or more of deleting a

performance component and replacing a performance component (column 2, lines 37-42 and

column 3, lines 1-9 and 25-27 and column 6, lines 19-29 and column 15, lines 8-30).

Regarding claims 6 and 17, Picco et al. teaches the method of claims 1 and 12, further

comprising adding a performance component to the performance prior to transmitting the one or

more portions of the received performance information (column 2, lines 37-42 and column 3,

lines 1-9 and 25-27 and column 6, lines 19-29 and column 15, lines 8-30).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claim 7 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

No. 6,029,045 to Picco et al. in view of Agraharam et al.

Referring to claims 7 and 18, Picco et al. teaches the method of claims 1 and 12, further

comprising: buffering the received performance information; wherein the transmitting the one or

more portions of performance is performed in response to the request for transmission of the

performance (column 2, lines 37-42 and column 3, lines 1-9 and 25-27 and column 6, lines 19-29

and column 15, lines 8-30).

Picco et al. does not teach and receiving a request. Agraharam et al. teaches and receiving

a request for transmission of the performance (column 1, lines 36-43). Therefore it would have

been obvious to one of ordinary skill in the art at the time the invention was made to further

modify the apparatus and method for inserting local content into programming content of Picco

et al. by receiving a request because this gives the user more control of the system.

4.   Claims 8 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

No. 6,029,045 to Picco et al. in view of Agraharam et al. as applied to claims 7 and 18 above,

and further in view of Raz.

Regarding claims 8 and 19, Picco et al. in view of Agraharam et al. teaches the method of

claims 7 and 18, further comprising: wherein the buffering the received performance information

is performed in response to the pause request (column 2, lines 37-42 and column 3, lines 1-9 and

25-27 and column 6, lines 19-29 and column 15, lines 8-30 of Picco et al.).

Picco et al. in view of Agraharam et al. does not teach and receiving a request. Raz

teaches receiving a pause request (column 1, lines 59-62). Therefore it would have been obvious

to one of ordinary skill in the art at the time the invention was made to further modify the

apparatus and method for inserting local content into programming content of Picco et al. in view

of Agraharam et al. by receiving a request because this gives the user more control of the system.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. The following patents are cited to further show the state of the art with respect to

private performance transmission in general:

   US Pat. No. 6,684,249 to Frerichs et al.

   US Pat No. 6,345,293 to Chaddha

6.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this
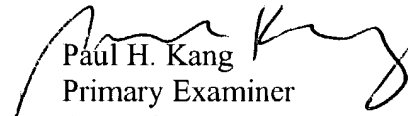
final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The

examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Paul H Kang can be reached on 703-308-6123. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April L Baugh   Paul H. Kang
Examiner   Primary Examiner
Art Unit 2141   Art Unit 2141

ALB